Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS D. TAGGART

Appeal No. 2002-1063
Application No. 09/306,552

ON BRIEF

Before COHEN, ABRAMS, and FRANKFORT, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-17, 19, 21 and 35. Claim 18 has been canceled and claims 20 and 22-34 have been withdrawn from consideration as being directed to a non-elected invention.

We REVERSE.

BACKGROUND

The appellant's invention relates to a method (claims 1-19 and 35) and apparatus (claim 21) for aseptically bottling aseptically sterilized foodstuffs. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Poole	2,491,015	Dec. 13, 1949
Gies	4,862,933	Sep. 5, 1989
Sizer et al. (Sizer)	5,770,232	Jun. 23, 1998
Olsson	5,799,464	Sep. 1, 1998

The following rejections stand under 35 U.S.C. § 103(a):

(1) Claims 1-11, 16, 17, 19, 21 and 35 on the basis of Gies in view of Olsson.

(2) Claim 12 on the basis of Gies in view of Olsson and Sizer.

(3) Claims 13 and 14 on the basis of Gies in view of Olsson and Poole.

(4) Claim 15 on the basis of Gies in view of Olsson, Poole and Sizer.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 19)[1] for the examiner's complete reasoning in support of the rejections, and

[1]This was a reissue of Paper No. 15 after remand from the Board because it failed to include claim 35 in the rejections.

to the Brief (Paper No. 14) and Reply Brief (Paper No. 16) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

All of the rejections are under 35 U.S.C. § 103(a). The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

At the outset, we take note of the appellant's explanation that aseptic packaging techniques require "that the packaging take place in a sterile environment, using presterilized containers, etc.," and his statement that "aseptic" denotes "the United States FDA level of aseptic" (specification, page 3). We also note that on page 4 of the specification the appellant describes the invention as incorporating many features "in order to meet the various United States FDA aseptic standards and the 3A Sanitary Standards and Accepted Practices," however, these have not been presented in the specification. Finally, the appellant states on page 5 of the Brief that "the term 'aseptic', as discussed throughout the invention, is clearly defined as meeting the strict definition of aseptic as promulgated by the United States Food and Drug Administration (page 10, line 22 - page 11, line 12.)" In view of the foregoing assertions on the part of the appellant, we shall consider the term "aseptic," as recited in the claims, as requiring the strict definition of aseptic as promulgated by the FDA, which includes operating in a sterile environment using pre-sterilized containers and related elements, such as lids, for example.

Claim 1 reads as follows:

> 1. A method of aseptically bottling aseptically sterilized foodstuffs comprising the steps of:
>
> providing a plurality of bottles;
>
> aseptically disinfecting the plurality of bottles to a level producing at least about a 6 log reduction in spore organisms;
>
> filling the aseptically disinfected plurality of bottles with the aseptically sterilized foodstuffs; and
>
> filling the aseptically disinfected plurality of bottles at a rate greater than 100 bottles per minute.

The claim stands rejected as being unpatentable over Gies in view of Olsson. Gies is directed to improving a device that delivers mists of sterilizing liquid to sterilize cups into which yoghurt or other dairy-type foodstuffs are to be packaged, and to the lids for the cups. In the course of setting forth this invention, Gies discloses an apparatus for packaging foodstuffs such as yoghurt in a cup and then sealing the cup by means of a circular foil disk. As described in column 4 and with reference to Figure 1, a picker device pulls cups 15 from a supply and fits them to seats 14 on a conveyor belt K. The cups then pass through a sterilizer apparatus 19 that sterilizes them with hydrogen peroxide, and they continue on to be filled with yoghurt by a machine 20. Sterilized cover disks are then set atop the filled and sterilized cups and sealed thereon. The rate at which the machine operates is 560 cups per minute.

As far as claim 1 is concerned, Gies fails to disclose or teach (1) using bottles as the container for the foodstuffs, (2) aseptically disinfecting the bottles to a level producing at least about a 6 log reduction in spore organisms, and (3) filling the bottles with aseptically sterilized foodstuffs.

It is the examiner's view that it would have been obvious to one of ordinary skill in the art to modify the Gies system by replacing the cups with bottles in view of Olsson, which discloses a system for aseptically transferring a plurality of pharmaceutical bottles. According to the examiner, the suggestion for doing so is "because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin, 125 USPQ 416*" (Answer, page 5). However, as we view this situation, the mere fact that the prior art system could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See, In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). And, in the present case, we fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to substitute a pharmaceutical bottle for the disclosed foil-covered yoghurt cup that used in the Gies system, considering that, to use the words attributed by the examiner to Leshin, the pharmaceutical bottles would appear not to be suitable for packaging yoghurt.

The examiner considers the step of aseptically disinfecting the bottles to a level producing at least about a 6 log reduction in spore organisms as being obvious "since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)"*

(Answer, page 5). We do not agree. While the Gies containers are sterilized, the claim requires that the containers be "aseptically" disinfected, that is, sterilized to the extent and in the environment required by the FDA standards, and such is not taught in this reference. In addition, there is no suggestion in Gies that spore organisms be reduced during the sterilization process, much less that it be "a 6 log" reduction. This being the case, we cannot subscribe to the examiner's position on this issue.

With regard to the requirement that the bottles be filled with aseptically sterilized foodstuffs, we agree with the examiner that the appellant's specification suggests that this technique is known in the art (page 3). However, Gies states that in the field of his invention "[t]he filling and sealing are done under substantially sterile conditions" (column 1, lines 16 and 17; emphasis added), which would mitigate against modification to aseptic disinfection, considering that this requires the operation to be performed in a sterile environment to FDA standards.

Because of the deficiencies explained above, it is our opinion that the combined teachings of Gies and Olsson do not establish a prima facie case of obviousness with regard to the subject matter recited in independent claim 1, and the rejection cannot be sustained. It follows that we also will not sustain the like rejection of claims 2-11 and 16, which depend from claim 1.

Independent claims 17, 19, 21 and 35 also stand rejected as being unpatentable over Gies and Olsson. All of these claims also require that the containers be bottles, and therefore the comments we made above regarding the lack of suggestion to substitute pharmaceutical bottles for the yoghurt cups in the Gies system are applicable here, and on that basis the rejection of these claims cannot be sustained. In addition, also as we discussed above, we do not agree with the examiner on the basis of the adduced evidence that "aseptic" sterilization of foodstuffs required by all of these claims is taught by the applied prior art, or that the requirement that such be to a level producing "at least about 12 log reduction in *Clostridium botulinum*" (claims 17, 21 and 35) and to a level producing "at least about a 6 log reduction in spore organisms" (claim 35), would have been obvious result effective variables to one of ordinary skill in the art. The rejection of claims 17, 19, 21 and 35 is not sustained.

Claim 12, which depends from claim 1, has been rejected on the basis on the basis of Gies and Olsson, taken further with Sizer, cited for teaching disinfecting a container by using oxonia, which is called for by claim 12. Be that as it may, Sizer does not overcome the shortcomings we found in the combination of Gies and Olsson against claim 1, and therefore we will not sustain the rejection of claim 12.

The comments regarding aseptically sterilized foodstuffs and bottles made above with regard to the rejection of the other independent claims also apply to claim

13, which includes the same limitations. The rejection of independent claim 13, and dependent claim 14, is not sustained.

Claim 15 depends from claim 1, and adds the requirement that the outside of the bottles be disinfected by oxonia. Poole has been applied, along with Gies and Olsson, for teaching sterilizing the outside of food containers, and Sizer for using oxonia for sterilizing food containers. However, these references do not alleviate the problems we found with the combination of Gies and Olsson, and thus we will not sustain the rejection of claim 15.

CONCLUSION

None of the rejections are sustained.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)))))) BOARD OF PATENT) APPEALS) AND) INTERFERENCES)))
NEAL E. ABRAMS Administrative Patent Judge	
CHARLES E. FRANKFORT Administrative Patent Judge	

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